

REMARKS

Claims 1-43 are pending in the Application. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

The Objections

Claim 42 has been amended as suggested by the Office. The Examiner's notice of the typographical error is appreciated.

The Rejections

Claims 1-42 were rejected under 35 U.S.C. § 102(e) as being anticipated by Gromley, et al. (US 6,146,057) ("Gromley").

Claims 5 and 20-22 were rejected under 35 U.S.C. § 103(a) as obvious over Gromley in view of Bustos (US 5,816,443).

Claim 25 was rejected under 35 U.S.C. § 103(a) as obvious over Gromley in view of Albert, et al. (US 5,991,410) ("Albert").

These rejections are respectfully traversed.

The Legal Standard

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

It is respectfully submitted that the Action does not meet these burdens.

The 35 U.S.C. § 102 Rejections

For brevity the Applicants do not necessarily present all of the reasons as to why the Gromley reference does not anticipate the claims. The Applicants reserve the right to later present additional reasons. Nevertheless, Applicants' arguments herein show that the Gromley reference does not disclose each and every feature, relationship and/or step arranged in the manner recited in the claims, as is required to sustain the rejections.

Gromley Does Not Anticipate The Claims

Claim 1

The Action alleges that Gromley teaches a pneumatic transfer apparatus (10) and an enclosure (34). The Action is silent as to what constitutes a movable cover, a cover drive, and a remote control device. The Applicants are familiar with the Gromley reference as it is owned by

the assignee of the present invention. Applicants respectfully disagree with the Office's interpretation and application of the Gromley reference.

Gromley does not teach an enclosure that "is adapted to house a card actuated terminal." The alleged enclosure (34) is not adapted to house a card actuated terminal. Gromley has a service provider terminal (22) and a customer terminal (24). The alleged enclosure (34) is actually a carrier housing (col. 5, lines 27-34). The carrier housing (34) is enabled to be moved between the terminals (22, 24). Gromley's carrier (32) has a diameter of about eight to ten inches (col. 6, lines 24-25). Thus, the carrier housing (34) is not adapted to house a terminal.

Additionally, there is no indication that either of Gromley's terminals (22, 24) comprises a card actuated terminal. In Gromley, the carrier (32) is adapted to carry the items (e.g., payment items, credit card vouchers, etc.) expected to be exchanged in a transaction related to a purchase (col. 6, lines 15-23). There is no need or reason for Gromley's terminals (22, 24) to comprise card actuated terminals. Also, the Action apparently admits that Gromley "fails to disclose a card-activated terminal" (Action page 9, lines 1-2). It follows that Gromley does not teach an enclosure that is adapted to house a card actuated terminal.

It further follows that Gromley does not teach a movable cover in supporting connection with the recited enclosure, especially where the cover is selectively movable between an open position (where the terminal is accessible from outside the enclosure) and a closed position (where access to the terminal from outside the enclosure is prevented).

The Action alleges (col. 5, lines 47-56) that Gromley teaches a "remote control device." However, it is unclear where the relied upon section of Gromley teaches a remote control device in operative connection with a drive (in operative connection with a movable cover, which is in

supporting connection with the enclosure), where an input to the remote control device is operative to cause the cover to move between open and closed positions. It appears that movement of the alleged cover (col. 6, lines 31-44) of Gromley is responsive to sensors (e.g., 194, 196).

It follows that Gromley does not anticipate claim 1. Again, for reasons of brevity the Applicants have not necessarily presented all of the reasons as to why Gromley does not anticipate the claim.

Furthermore, Applicants respectfully request clarification of the rejection. The Action is silent as to what specific numbered components in Gromley constitute the alleged movable cover, a cover drive, and a remote control device. The Action does not state in any way that is reasonably understandable by Applicants where the specific features recited in Applicants' claim are allegedly found in Gromley.

Gromley clearly identifies therein all of the different elements with corresponding reference numerals. Therefore, Applicants respectfully request that the Office state on the record which reference numerals in Gromley allegedly correspond to Applicants' recited elements. Note MPEP 707.07(d). The Action's failure to specifically indicate the alleged movable cover, a cover drive, and a remote control device in the Gromley reference has been taken by the Applicants as an admission by the Office that the reference does not meet the recited claim features.

Claim 27

Applicants' remarks in support of the patentability of claim 1 are incorporated by reference as if fully rewritten herein. Gromley does not teach a payment terminal in the interior

area of an enclosure. Nor does Gromley teach opening an enclosure cover to enable a customer at a customer station to access an input device on the payment terminal. Where does Gromley teach the recited relationship of the enclosure, cover, payment terminal, and input device? It follows that Gromley does not anticipate the claim.

Additionally, claim 27 was rejected pursuant to 35 U.S.C. § 102(e). However, the Action relies on Gromley "providing a payment terminal in view of Bustos." Thus, the Action admits that Gromley alone does not teach a payment terminal. Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. Thus, Gromley does not anticipate the claim. Again, for reasons of brevity the Applicants have not necessarily presented all of the reasons as to why Gromley does not anticipate the claim.

The Dependent Claims

Each of the dependent claims depends directly or indirectly from an independent claim. The independent claims have been previously shown to be allowable. Thus, it is asserted that the dependent claims are allowable on the same basis.

Furthermore, each of the dependent claims additionally recites specific features and relationships that patentably distinguish the claimed invention over the applied art. None of the reference(s), taken alone or in combination, teach or suggest the features and relationships that are specifically recited in the dependent claims. Thus, it is respectfully submitted that the dependent claims are further allowable due to the recitation of such additional features and relationships.

The 35 U.S.C. § 102(e) rejections of claims 9, 19, 31, 40, and 43 rely on teachings other than Gromley. Thus, Gromley does not anticipate these claims.

Neither Bustos nor Albert can alleviate the previously discussed deficiencies (nor the admitted deficiencies) in Gromley as they also do not teach or suggest the recited features and relationships which are not found in Gromley. For example, neither Bustos nor Albert teach or suggest an enclosure that is adapted to house a card actuated terminal. Nor does Bustos or Albert teach or suggest a movable cover in supporting connection with the recited enclosure, especially where the cover is selectively movable between an open position (where the terminal is accessible from outside the enclosure) and a closed position (where access to the terminal from outside the enclosure is prevented). Thus, neither Gromley nor Bustos, taken alone or in combination, disclose or suggest the features and relationships that are specifically recited in the claims. Likewise, neither Gromley nor Albert, taken alone or in combination, disclose or suggest the features and relationships that are specifically recited in the claims. The applied art is devoid of any teaching, suggestion, or motivation for combining features of the applied art so as to produce the recited invention. Nor has the Office established a *prima facie* showing of obviousness.

Allowability

Claim 43 has not been rejected on the merits. The inferred allowability of claim 43 is greatly appreciated.

Versions With Markings To Show Changes Made

In the Claims

25. (once amended) The system according to claim 23 wherein the card actuated [activated] terminal comprises a terminal adapted to communicate through wireless communication methods.

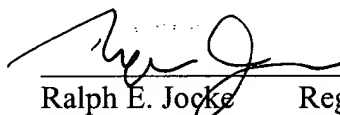
42. (once amended) The method according to claim 27 [23] wherein in step (a) the enclosure comprises a carrier movable in a pneumatic tube.

Conclusion

Each of Applicants' pending claims specifically recite features, relationships, and/or steps that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicants' invention. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,



Ralph E. Jocke Reg. No. 31,029
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000